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			EXAMINER	
			MIRZADEGAN, SAEED S	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/761,059

Applicant(s)

PASTRO ET AL.

Examiner

Saeed S. Mirzadegan

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/13/2005</u>                                                | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 5/31/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "step 395" has been used to designate both to "Display IM Menu" and "Set Status to Offline". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. **Claim 11** is objected to because of the following informalities: Claim 11, recites "The apparatus of claim 10 wherein said first device a digital telephone". As recited the

claim does not have a verb. It should read "The apparatus of claim 10 wherein said first device is a digital telephone".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention

4. **Claims 4, 10, 17, 35** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. **Claim 4 & 35** recite the limitation "a first protocol device" page 17, line 20 & page 21, line 1. There is insufficient antecedent basis for this limitation in the claim.

6. Insofar as best understood, the claim is rejected over prior art as follows. For the sake of applying the closest prior art below, the term "a first protocol device" is being interpreted as meaning "using a protocol". If the applicant agrees with this interpretation they are invited to amend the claims to positively recite, "using a protocol" or if the applicant disagrees, the applicant should present an alternate interpretation with clear arguments.

7. **Claim 10** recites the limitation "a second protocol device" page 18, line 4. There is insufficient antecedent basis for this limitation in the claim.

8. Insofar as best understood, the claim is rejected over prior art as follows. For the sake of applying the closest prior art below, the term "a second protocol device" is being interpreted as meaning "using a protocol". If the applicant agrees with this interpretation they are invited to amend the claims to positively recite, "using a protocol" or if the applicant disagrees, the applicant should present an alternate interpretation with clear arguments.

9. **Claim 17** recites the limitations "first protocol device" and "second protocol device" on page 18, lines 32-33 & page 19, line 1. There is insufficient antecedent basis for this limitation in the claim.

10. Insofar as best understood, the claim is rejected over prior art as follows. For the sake of applying the closest prior art below, the term "a first protocol device" & "a second protocol device" is being interpreted as meaning "a device using a protocol". If the applicant agrees with this interpretation they are invited to amend the claims to positively recite, "a device using a protocol" or if the applicant disagrees, the applicant should present an alternate interpretation with clear arguments.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 1-19, 21, 24, 32-46** are rejected under 35 U.S.C. 102(e) as being anticipated by “Wengrovitz et al.” (US PG Pub. No. 2004/0205209) hereafter “Wengrovitz”.
12. Regarding **Claim 1**, Wengrovitz discloses, an apparatus comprising:
  - a. a first device (**Fig. 1, 16**) **Sip set utilizing SIP protocol**;
  - b. a second device implementing a second protocol (**Fig. 1, 12**) **Digital Set utilizing PDSV protocol**;
  - c. a protocol converter to convert between said first protocol and said second protocol (**Fig. 1, 26**) **Protocol Converter**;
  - d. a register to register said first device and said second device (**Fig. 1, 18**) **& (Fig. 5B) & (Page 4, ¶0067) SIP-PBX proxy server, registers the first device and the second device**;
  - e. a map to map a first client to said first device and a second client to said second device (**Fig. 3, 40**) **port mapping table, maps the first client to the first device and the second client to the second client**.

Art Unit: 2144

13. Regarding **Claim 2**, Wengrovitz discloses, the apparatus of claim 1 wherein said first protocol is a Session Initiation Protocol (SIP) **(Fig. 1, 16) Sip set utilizing SIP protocol.**

14. Regarding **Claim 3**, Wengrovitz discloses, the apparatus of claim 2 wherein said second protocol is a Computer Supported Telephony Application (CSTA), **(Fig. 29, ¶0113, lines 1-4) Computer Supported Application (CSTA) is a supported protocol.**

15. Regarding **Claim 4**, Wengrovitz discloses, the apparatus of claim 3 wherein said first device is a first protocol device **(Fig. 1, 16) & (Fig. 29) Sip set utilizing SIP protocol.**

16. Regarding **Claim 5**, Wengrovitz discloses, the apparatus of claim 4 wherein said first device is a Personal Computer (PC) **(Fig. 29, ¶0113) the utilization of Computer Telephony Integration (CTI) which necessitates the usage of a computer (PC).**

17. Regarding **Claim 6**, Wengrovitz discloses, the apparatus of claim 4 wherein said first device is a Personal Digital Assistant (PDA) **(Fig. 29, ¶0113) the utilization of Computer Telephony Integration (CTI) which necessitates the usage of a PAD which is a type of computer (PC).**

Art Unit: 2144

18. Regarding **Claim 7**, Wengrovitz discloses, the apparatus of claim 3 wherein said second device is a digital telephone **(Fig. 1, 12) & (Fig. 29) Digital set.**

19. Regarding **Claim 8**, Wengrovitz discloses, the apparatus of claim 7 wherein said digital telephone is connected through a telephonic switch **(Fig 1, 10) & (Fig. 29) IP-PBX.**

20. Regarding **Claim 9**, Wengrovitz discloses, the apparatus of claim 8 wherein said telephonic switch is a Private Branch Exchange (PBX) **(Fig 1, 10) & (Fig. 29) IP-PBX.**

21. Regarding **Claim 10**, Wengrovitz discloses, the apparatus of claim 3 wherein said first device is a second protocol device **(Fig. 1, 16) & (Fig. 29) SIP set utilizing SIP protocol.**

22. Regarding **Claim 11**, Wengrovitz discloses, the apparatus of claim 10 wherein said first device a digital telephone **(Fig. 1, 12) & (Fig. 29) Digital set.**

23. Regarding **Claim 12**, Wengrovitz discloses, the apparatus of claim 11 wherein said digital telephone is connected through a telephonic switch **(Fig 1, 10) & (Fig. 29) IP-PBX.**



24. Regarding **Claim 13**, Wengrovitz discloses, the apparatus of claim 12 wherein said telephonic switch is a Private Branch Exchange (PBX) **(Fig. 1, 10) & (Fig. 29) IP-PBX.**

25. Regarding **Claim 14**, Wengrovitz discloses, a method comprising the steps of:

f. registering a first protocol digital telephone set **(Fig. 1, 18) & (Fig. 5B) & (Page 4, ¶0067) SIP-PBX proxy server, registers the first device and the second device;**

g. converting said first protocol to a second protocol **(Fig. 1, 26) Protocol Converter**

h. mapping a client to said digital telephone set **(Fig. 3, 40) port mapping table, maps the first client to the first device and the second client to the second client;**

i. communicating an instant message to or from said digital telephone set **(Fig. 12, 144, ¶0085, lines 7-12) an Instant message is transmitted with each key press.**

26. Regarding **Claim 15**, Wengrovitz discloses, the method of claim 14 furthering comprising the steps of:

j. registering a second device **(Fig. 1, 18) & (Fig. 5B) & (Page 4, ¶0067) SIP-PBX proxy server, registers the first device and the second device;**

k. wherein said mapping step further maps a second client to said second device **(Fig. 3, 40) port mapping table, maps the first client to the first device and the second client to the second client** and said communicating step further includes communicating an instant message between said first digital telephone set and said second device **(Fig. 12, 144, ¶0085, lines 7-12) an Instant message is transmitted with each key press.**

27. Regarding **Claim 16**, Wengrovitz discloses, the method of claim 15 wherein said second device is a personal computer (PC) **(Fig. 29, ¶0113) the utilization of Computer Telephony Integration (CTI) which necessitates the usage of a computer (PC);** and wherein said mapping step further maps a second client to said PC **(Fig. 3, 40) port mapping table, maps the first client to the first device and the second client to the second client;** and said communicating step further includes communicating an instant message between said first digital telephone set and said PC **(Fig. 12, 144, ¶0085, lines 7-12) an Instant message is transmitted with each key press.**

28. Regarding **Claim 17**, Wengrovitz discloses, the method of claim 15 wherein said second device is a first protocol digital telephone set **(Fig. 1, 12) Digital Set utilizing PDSV protocol;** and wherein said converting step also converts said first protocol device to said second protocol device **(Fig. 1, 26) Protocol Converter,** said mapping step further maps a second client to said second digital telephone set **(Fig. 3, 40) port**

**mapping table, maps the first client to the first device and the second client to the second client and said communicating step further includes communicating an instant message between said first and said second digital telephone sets (Fig. 12, 144, ¶0085, lines 7-12) an instant message is transmitted with each key press.**

29. Regarding **Claim 18**, Wengrovitz discloses, a method according to claim 14 further comprising the step of configuring an Instant Messaging (IM) key for a digital telephone set **(Fig. 12, 144, ¶0085, lines 7-12) an instant message is transmitted with each key press.**

30. Regarding **Claim 19**, Wengrovitz discloses, a method according to claim 18 further comprising the step of establishing the IM connection by pressing said instant messaging key **(Fig. 12, 135, ¶0085, lines 4-7) an instant message is transmitted without a dialed number with pressing the key.**

31. Regarding **Claim 21**, Wengrovitz discloses, a method according to claim 14 wherein said step of communicating is accomplished while the digital telephone set is off-hook **(Fig. 12, 135, ¶0085, lines 4-7) user is off-hook and an instant message is transmitted without a dialed number with pressing the key.**

32. Regarding **Claim 24**, Wengrovitz discloses, a method according to claim 14 wherein said step of communicating includes using said digital telephone set to sign-in

Art Unit: 2144

and sign-out for instant messaging services (**Fig. 12, 135, ¶0085, lines 4-7**) **user is off-hook and an Instant message is transmitted without a dialed number with pressing the key.**

33. **Claim 32** list all the same elements of claim 1, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 1 applies equally as well to claim 32.

34. **Claim 33** list all the same elements of claim 2, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 2 applies equally as well to claim 33.

35. **Claim 34** list all the same elements of claim 3, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 3 applies equally as well to claim 34.

36. **Claim 35** list all the same elements of claim 4, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 4 applies equally as well to claim 35.

Art Unit: 2144

37. **Claim 36** list all the same elements of claim 5, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 5 applies equally as well to claim 36.

38. **Claim 37** list all the same elements of claim 7, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 7 applies equally as well to claim 37.

39. **Claim 38** list all the same elements of claim 8, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 8 applies equally as well to claim 38.

40. **Claim 39** list all the same elements of claim 9, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 9 applies equally as well to claim 39.

41. **Claim 40** list all the same elements of claim 10, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 10 applies equally as well to claim 40.

Art Unit: 2144

42. **Claim 41** list all the same elements of claim 11, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claim 11 applies equally as well to claim 41.

43. **Claim 42** list all the same elements of claim 14, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 14 applies equally as well to claim 42.

44. **Claim 43** list all the same elements of claim 15, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 15 applies equally as well to claim 43.

45. **Claim 44** list all the same elements of claim 16, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 16 applies equally as well to claim 44.

46. **Claim 45** list all the same elements of claim 17, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 17 applies equally as well to claim 45.

Art Unit: 2144

47. **Claim 46** list all the same elements of claim 18, but in system form rather than method form. Therefore, the supporting rationale of the rejection to claim 18 applies equally as well to claim 46.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

48. **Claims 20, 22, 28-31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wengrovitz in view of Chavez et al. (US PG Pub. NO. 2005/0013421) hereinafter "Chavez".

49. Regarding **Claim 20**, Wengrovitz as applied to claim 14 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly teach: sending a notification to said digital telephone set when a new instant message arrives.

50. In the same field of endeavor, Chavez teaches, **(¶0084) ring tone notifies the user of the receipt of the message.**

51. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of sending a notification when a message arrives with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages **(see Chavez, abstract, lines 2-4)**. Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol **(see Wengrovitz, abstract, lines 10-12)**.

52. Regarding **Claim 22** Wengrovitz as applied to claim 14 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly teach: communicating includes composing and displaying instant messages using the standard key buttons and display space of said digital telephone set.



53. In the same field of endeavor, Chavez teaches, **(Fig. 7, ¶0035, lines 9-11) using a phone to compose and display instant messages using its key buttons and display.**

54. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages **(see Chavez, abstract, lines 2-4)**. Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol **(see Wengrovitz, abstract, lines 10-12)**.

55. Regarding **Claim 28** Wengrovitz as applied to claim 14 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly teach: communicating includes sending stored common replies to other instant messaging clients.

56. In the same field of endeavor, Chavez teaches, **(¶0086, lines 2-4) the message is saved and then sent as a response.**

57. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of saving the message and then sending it as response with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages **(see Chavez, abstract, lines 2-4)**.

Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol **(see Wengrovitz, abstract, lines 10-12)**.

58. Regarding **Claim 29** Wengrovitz and Chavez as applied to claim 28 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field.

59. In the same field of endeavor, Chavez teaches, **(¶0086, lines 2-4) the stored text message is a text response created by the user.**

60. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of saving the message and then sending it as response with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages **(see Chavez, abstract, lines 2-4)**.

Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (**see Wengrovitz, abstract, lines 10-12**).

61. Regarding **Claim 30** Wengrovitz and Chavez as applied to claim 14 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly teach: sending stored common messages to other instant messaging clients.

62. In the same field of endeavor, Chavez teaches, (**¶0087 & ¶0088**) **the stored text message is transmitted in response to the sender.**

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of transmitting the stored response to the sender with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (**see Chavez, abstract, lines 2-4**). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (**see Wengrovitz, abstract, lines 10-12**).

63. Regarding **Claim 31** Wengrovitz and Chavez as applied to claim 30 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly

teach: at least one of said stored common replies includes at least one custom data field.

64. In the same field of endeavor, Chavez teaches, (**¶0022, lines 11-17**) **stored text messages are associated or mapped to key's, these messages can be customized by the user.**

65. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of stored messages can have customized fields with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (**see Chavez, abstract, lines 2-4**). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (**see Wengrovitz, abstract, lines 10-12**).

### ***Claim Rejections - 35 USC § 103***

66. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wengrovitz in view of Northcutt (US PG Pub. No. 2005/0059418) hereafter "Northcutt ".

67. Regarding **Claim 23** Wengrovitz as applied to claim 14 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly teach:

Art Unit: 2144

sending a notification to said digital telephone set when a request to add said digital telephone set client to the contact list of another instant messaging client is received.

68. In the same field of endeavor, Northcutt teaches, (**¶0006**) **the users are informed when a contact list is created and is transmitted in order to upload the new client list to other users.**

69. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Northcutt's teachings of notification of uploading the client list with the teachings of Wengrovitz, to allow groups of mobile phone users that share common contacts to effortlessly update their respective contact lists (**see Northcutt, abstract & ¶0003**). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (**see Wengrovitz, abstract, lines 10-12**).

### ***Claim Rejections - 35 USC § 103***

70. **Claim 25** is rejected under 35 U.S.C. 103(a) as being unpatentable over Wengrovitz in view of Jerbi et al. (DE10127360) hereafter "Jerbi".

71. Regarding **Claim 25** Wengrovitz as applied to claim 14 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly teach:

Art Unit: 2144

communicating includes using said digital telephone set to change the on-line and off-line status of said digital telephone set for instant messaging.

72. In the same field of endeavor, Jebri teaches, **(abstract) the user is informed of the status of other partners for the purpose of instant messaging.**

73. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Jebri's teachings of phone status with the teachings of Wengrovitz, for the purpose of providing user with partner status **(see Jebri, title & abstract)**. Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol **(see Wengrovitz, abstract, lines 10-12)**.

### ***Claim Rejections - 35 USC § 103***

74. **Claims 26, 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wengrovitz in view of Lee (US PG Pub. No. 2005/0108348) hereafter "Lee".

75. Regarding **Claim 26** Wengrovitz as applied to claim 14 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly teach: using said digital telephone set to query the status of a contact list member.

Art Unit: 2144

76. In the same field of endeavor, Lee teaches, **(abstract & ¶0036, lines 4-9) user monitors the status of a contacts list or personal list of clients from the address book.**

77. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Lee's teachings of contacts list status monitoring with the teachings of Wengrovitz, for the purpose of permitting the user to selectively control the level of status information received for each user or endpoint in a communication group **(see Lee, ¶0007, lines 9-11)**. Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol **(see Wengrovitz, abstract, lines 10-12)**.

78. Regarding **Claim 27** Wengrovitz as applied to claim 14 above substantially discloses the invention as claimed. However Wengrovitz does not explicitly teach: determining the presence status of said digital telephone based on call activity of said digital telephone.

79. In the same field of endeavor, Lee teaches, **(abstract & ¶0036, lines 4-9) user monitors the status of a contacts list. Since the contacts list are generated based on the call activity, therefore the status is being monitored based on the call activity.**

80. It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Lee's teachings of monitoring the status based on the contacts list which itself is based on call activity with the teachings of Wengrovitz, for the purpose of permitting the user to selectively control the level of status information received for each user or endpoint in a communication group (see Lee, ¶0007, lines 9-11). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form PTO-892 (Notice of Reference Cited) for a list of relevant prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeed S. Mirzadegan whose telephone number is 571-270-3044. The examiner can normally be reached on M-F 8:00-5:00.

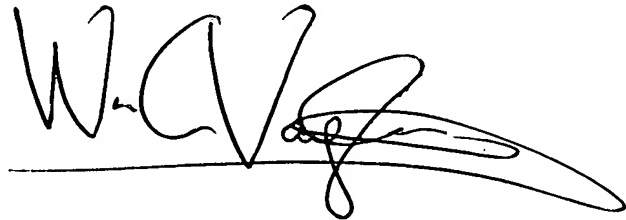
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 2144

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SSM

A handwritten signature in black ink, appearing to read 'W. Vaughn', with a long horizontal flourish extending to the right.

WILLIAM VAUGHN  
SUPERVISORY PATENT EXAMINER  
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